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ART UNIT

PAPER NUMBER

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/017,329

Applicant(s)
Matsukura

Examiner
Jason D. Cardone

Group Art Unit
2756



☒ Responsive to communication(s) filed on May 19, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-16 is/are pending in the application.

Of the above, claim(s) 12-15 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-11 and 16 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Claims 12-15 are withdrawn from further consideration pursuant to 37 CAR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in Paper No. 7.

2. Applicant's election with traverse of Group 1 (claims 1-11 and 16) in Paper No. 7 is acknowledged. The traversal is on the ground(s) that all of the claims share the same features that a mobile computer recognizes the server and receives notice on resources from the server. This is not found persuasive because there are other limitations within each group which are distinct. Paper No. 7 outlines the differences in the claims. Also, Group II (claims 12 and 13) show of the replying means for replying the resource information which is the content of the own resource information managing means when receiving the predetermined message. This is not a limitation to Group I or III. As for Group III (claims 14 and 15), mobile radio communication is a different environment than Groups I and II.

The requirement is still deemed proper and is therefore made FINAL.

3. This application contains claims 12-15 are drawn to an invention nonelected with traverse in Paper No. 7. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CAR 1.144) See MPEP § 821.01.

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Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. ^{1-11,16}~~1-16~~ Claims ~~1-16~~ are rejected under 35 U.S.C. 103(a) as being unpatentable over Brabson et al ("Brabson"), U.S. Patent No. 5,715,395, in view of Rybicki et al. ("Rybicki"), U.S. Patent No. 5,630,081.

6. Regarding claim 10, Brabson discloses a computer network system in which plural connecting means capable of connecting a computer is provided in a network circuit to which a computer is connected to one of the connecting means [Brabson, col. 5, lines 20-55], wherein the connecting means comprises resource information managing means for managing the information relating to the resources, including the physical location of the resources, which are usable through the network circuit near each installation position, resource information noticing means for noticing the content of the resource information managing means when the computer system is connected, and updated resource information registering means for updating and registering the content of the resource information managing means by receiving updated resource information from the computer [Brabson, col. 1, lines 61-65, col. 3, lines 44-11 col. 5, lines 37-67, col. 7, lines 30-65, col. 9, lines 28-64, and col. 17, lines 25-62];

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the computer comprises resource information receiving means for receiving the resource information managed by the resource information managing means noticed by the resource information noticing means, resource setting means for setting the resource according to the resource information received by the resource information receiving means, and updated resource information noticing means for noticing the updated resource information to the connecting means in order to update the content of the resource information managing means of the connecting means [Brabson, col. 9, line 28 - col. 10, line 39, col. 15, line 44 - col. 16, line 58, and col. 17, lines 25-62], and

when the computer is connected to the network circuit through any one of the plural connecting means, the resource information receiving means receives the resource information managed by the resource information managing means noticed from the resource information noticing means, and the resource setting means sets the resource according to the resource information received by the resource information receiving means [Brabson, col. 9, line 28 - col. 10, line 39, col. 15, line 44 - col. 16, line 58, and col. 17, lines 25-62].

Brabson mentions mobile computers (i.e. notebooks) [Brabson, col. 2, lines 6-26] but does not expressly teach the use of mobile computers to disconnect in their system. However, Rybicki, in the same field of endeavor, does expressly disclose the use of mobile computers (i.e. portable computers) with updating of information for itself [Rybicki, col. 2, lines 20-53, col. 4, lines 36-67, col. 8, lines 34-67, and col. 12, lines 52-65]. The field of invention of Brabson is reducing network traffic with locating and accessing resources in large networks [Brabson, col. 1,

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lines 6-10]. The field of invention of Rybicki is connecting mobile computers to remote resources [Rybicki, col. 2, lines 20-31]. Both Brabson and Rybicki try to connect computers to remote resources. Brabson reduces the time of the connection and Rybicki displays the connection time to the end user. This interworking of a quicker connection with aesthetically pleasing the end user makes Brabson and Rybicki analogous to each other. It would have been obvious to one having ordinary skill in the art at the time the invention was made to be able connect portable computers, taught by Rybicki, into the network communication system, taught by Brabson, in order to improve the flexibility of the system. The system, now, can have portable computers connect to it all over the world.

Therefore, it would have been obvious to combine Brabson and Rybicki (Brabson-Rybicki) to obtain the invention as specified in claim 10.

7. Regarding claim 11, Brabson-Rybicki further discloses:

the connecting means further comprises updated resource information transmitting means for sending out updated resource information to the network circuit when the content of the resource information managing means is updated, and updated resource information receiving means for updating the content of the resource information managing means when receiving the updated resource information from the network circuit [Brabson, col. 9, line 28 - col. 10, line 39, col. 15, line 44 - col. 16, line 58, and col. 17, lines 25-62],

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when updated resource information is noticed from the updated resource information noticing means to the connecting means, the updated resource information transmitting means sends out the updated resource information to the network circuit [Brabson, col. 9, line 28 - col. 10, line 39, col. 15, line 44 - col. 16, line 58, and col. 17, lines 25-62], and

the updated resource information receiving means, when receiving the updated resource information from the network circuit, updates the content of the resource information managing means according to the received updated resource information [Brabson, col. 9, line 28 - col. 10, line 39, col. 15, line 44 - col. 16, line 58, and col. 17, lines 25-62].

8. Claims 1-9 and 16 have similar limitations as claims 10-11. Therefore, they are rejected under Brabson-Rybicki for the same reasons set forth in the rejection of claims 10-11 [Supra 10-11].

Response to Arguments

9. Applicant's arguments filed 2/7/00 have been fully considered but they are not persuasive.

In the remarks, Applicant argued in substance that:

10. (A) Brabson fails to disclose the reception of any resource information transmitted by a first managing computer, much less information regarding the physical location of the resource.

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As to point (A), Brabson discloses the use of Network nodes (manager computers) and end nodes (client/user/second computers) within its system [Brabson, col. 5, lines 20-36]. The Network node will locate and obtain characteristics of the target computer (resource) [Brabson, col. 5, lines 36-55]. The location and characteristics of the target computer (resource) can be stored on the Network node and the end node, once the Network node obtains the resource information [Brabson, col. 6, lines 4-26]. The location is the physical address (physical location) of the resource [Brabson, col. 1, lines 61-65 and col. 3, lines 44-11].

11. (B) Brabson fails to disclose any reference to the physical location of the sought network resources.

As to point (B), Brabson discloses that the locating information of the target computer (network resource) is the physical address of the target (network resource) [Brabson, col. 1, lines 61-65 and col. 3, lines 44-11].

12. (C) Rybicki fails to disclose first computer resource information means for managing information relating to network resources.

As to point (C), Rybicki discloses the use of mobile computers (i.e. portable/disconnecting computers) with updating of information for itself [Rybicki, col. 2, lines 20-53, col. 4, lines 36-67, col. 8, lines 34-67, and col. 12, lines 52-65]. One cannot establish non-obviousness by attacking references individually where, as here, the rejection is

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based on combinations of references. *In re Merck & Co.*, 800 F.2d 1091, 1097 231 USPQ 375, 380 (Fed. Cir. 1986) (citing *In re Keller*, 642 F.2d 413, 426, 208 USPQ 871, 880 (CCPA 1981)). In determining obviousness, furthermore, references are read not in isolation but for what they fairly teach in combination with the prior art as a whole. *Id.* at 1097, 231 USPQ at 380. The Examiner accordingly demurs to this assertion because it is the combination Brabson-Rybicki rather than Rybicki alone that discloses first computer resource information means for managing information relating to network resources.

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

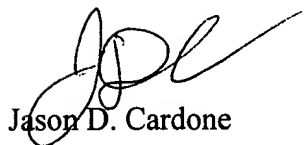
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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CAR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason D. Cardone, whose telephone number is (703) 305-8484. The examiner can normally be reached on Monday through Friday from 8:00am to 4:30pm.

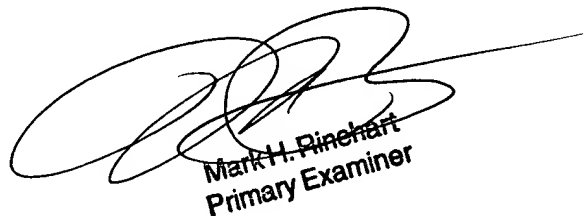
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart, can be reached on (703) 305-4815.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist, whose telephone number is (703) 305-9700.



Jason D. Cardone

August 10, 2000



Mark H. Rinehart
Primary Examiner